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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/824,092      | 04/03/2001  | Yoshitaka Nagao      | 35.C15264           | 9326             |

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NEW YORK, NY 10112

EXAMINER

COLE, ELIZABETH M

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1771

DATE MAILED: 03/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-7

|                              |                                      |                                     |  |
|------------------------------|--------------------------------------|-------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/824,092 | <b>Applicant(s)</b><br>NAGAO ET AL. |  |
|                              | <b>Examiner</b><br>Elizabeth M Cole  | <b>Art Unit</b><br>1771             |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-94 is/are pending in the application.
- 4a) Of the above claim(s) 4,23-27 and 29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 and 28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All   b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |                                                                                              |                                                                             |
|----------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

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1. Applicant's election with traverse of Group I in Paper No. 6 is acknowledged. The traversal is on the ground(s) that the examination of all the claims would not present an undue burden. This is not found persuasive because the claims are drawn to distinct inventions as set forth in the restriction requirement and the issues and field of search involved would necessarily be divergent.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 1-22 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claimed structure is unclear. Does claim 1 recite a material comprising a waterproofing layer comprising a flame resistive fiber impregnated with a resin, (filler), and a flame resistive fiber layer which is not impregnated with the resin wherein the flame resistive fiber layer is disposed in the waterproofing layer? Claim 1 recites that "said flame resistive layer is located in a surface of said facing material." Does this mean that it is embedded in the facing material. If so, how could at least some of it not be impregnated with the resin?

While applicant may be his or her own lexicographer, a term in a claim may not be given a meaning repugnant to the usual meaning of that term. See *In re Hill*, 161 F.2d 367, 73 USPQ 482 (CCPA 1947). The term "filler" in claim 1 is used by the claim to mean "resin," while the accepted meaning is "an additive which is incorporated into a resin to modify its appearance, properties, etc.." Also, with regard to claim 4, since the water absorption preventing layer is the same as the waterproofing layer, how does claim 4 further limit claim 1? A similar problem is

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present in claim 9. In claim 6, it is not clear whether a single facing material or multiple facing materials are being claimed. Also, the overall structure being claimed in claim 6 is not clear. Specifically, the claim recites “the unexposed region is a region of the surface of said facing material exposed to outside”. How can an unexposed region be the region that is exposed? Similarly, “the exposed region is a region of the surface said facing material not exposed to outside.” The structure of claim 6 is so unclear as to preclude the application of prior art to the claim. Similar problems are present in claims 7-8, 10-13, 18-19. The structure is so unclear as to preclude examination. Claims 21 and 22 do not recite any method steps and are therefore indefinite. Additionally, it is not clear what is meant by “a state of winding it in a longitudinal direction”, claim 21, or “state of stacking it in the same direction when it is transported and kept”, claim 22. What direction is being referred to?

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-5, 9, 15-17,20 rejected under 35 U.S.C. 102(b) as being anticipated by Nath et al, U.S. Patent No. 5,474,620. Nath et al discloses a material comprising a plurality of layers of fiber glass and thermoplastic resin wherein the layers are subjected to heat and pressure sufficient to cause the resin to flow and impregnate at least a portion of the fiber glass layers. See col. 5, lines 50-60 and col. 6, lines 33-41. Fiber glass is inherently flame resistant. The layers may be

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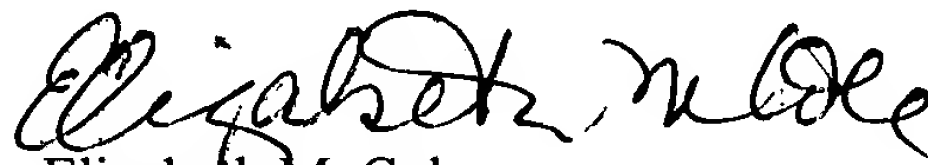
further provided with a protective layer. The layers may be bonded to a metal substrate. See col. 4, lines 7-22. The thicknesses of the respective layers set forth in col. 8, lines 8-39, would produce a flexible material.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth M. Cole whose telephone number is (703) 308-0037. The examiner may be reached between 6:30 AM and 5:00 PM Monday through Thursday.

Mr. Terrel Morris, the examiner's supervisor, may be reached at (703) 308-2414.

Inquiries of a general nature may be directed to the Group Receptionist whose telephone number is (703) 308-0661.

The fax number for official faxes is (703) 872-9310. The fax number for official after final faxes is (703) 872-9311. The fax number for unofficial faxes is (703) 305-5436.



Elizabeth M. Cole  
Primary Examiner  
Art Unit 1771

e.m.c  
March 18, 2003